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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/649,268	08/28/2000	Michael S. Chartier	042390.P219	6762

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EXAMINER

SCHNEIDER, JOSHUA D

ART UNIT

PAPER NUMBER

2182

DATE MAILED: 03/16/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Pf

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/649,268	CHARTIER, MICHAEL S.	
	Examiner Joshua D Schneider	Art Unit 2182	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 February 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 7/25/2003 have been fully considered but they are not persuasive. With regards to the arguments that U.S. Patent 5,748,084 to Isikoff does not teach a first processor and a second processor, Applicant is directed to Figures 3 and 4. Isikoff teaches an activated modem processor that receives and stores data (Fig. 3, column 3, lines 62-65, and column 5, lines 54-49) while a first central processor of the host computer is deactivated (Fig. 4, column 9, lines 15-27). The processor of the modem (beacon) operates independently of the processor of the host computer.
2. With regards to the arguments that any activity taught by Isikoff involving the data modem also involves the microprocessor (30), applicant again pointed to Figs. 3 and 4. It is shown in these figures that there are in fact two processors in the system, one of which can be inactive while the second, resident in the modem, remains active for the sending and receiving of communications. Microprocessor 30 in the beacon remains active, while the host processor of the computer in which the beacon resides is inactive.
3. With regards to the argument that the user does not use the data stored by the beacon, the applicant has presented points to only parts of the reference that may seem to help the argument. In the previous argument, the applicant cited sections of the reference that make it quite clear that the data is for use by the user. It is unclear how the sending of voice calls, emails, and even control codes can be interpreted as for the use of anything but a user (page 7, paragraph 4).

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claim 8 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is made clear that the data is stored for future use, but not how the data is to be used without the first processor.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regards to claims 1 and 3, the use of the terms processor and modem processor creates confusion, as the name of the first element is included in the name of the second element. Clarification of the term processor is therefore required.

8. All further objections and rejections are made in view of the specification as best understood in light of the previous objections and rejections.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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10. Claims 8-9, 13-14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,748,084 to Isikoff. With regards to claim 8, Isikoff teaches an activated modem processor which receives and stores data for future use by a user (Fig. 3, column 3, lines 62-65, and column 5, lines 54-49) when a first processor of the host computer is deactivated (Fig. 4, column 9, lines 15-27).

11. With regards to claim 9, Isikoff teaches the beacon unit controls the power supply (column 4, lines 15-20, column 2, lines 12-14, and column 9, lines 15-17).

12. With regards to claims 13 and 14, Isikoff teaches the processor stores in memory user file names and types which are to be transferred (column 6, lines 5-11).

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1-7, 10-12, 15, 16, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,748,084 to Isikoff. With regards to claims 1, 18, and 19, the Isikoff reference teaches a beacon unit (Fig. 3) comprising a modem adapted to receive communication for future use by a user, a processor coupled to the modem (Fig. 4), and a memory coupled to the modem when the processor is inactive (column 3, line 62, through column 4, line 2, and column 9, lines 15-27). It is inherent that a user programs the processes of the modem, as there is no other way for the modem to be functional in such a manner. While Isikoff does not explicitly teach non-volatile memory, the beacon is battery backed and retains

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power even when power is removed from the main computer and processor (Figs. 3 and 4). It would have been obvious to one of ordinary skill in the art at the time of invention that the beacon memory of Isikoff is battery backed and is therefore nonvolatile.

15. With regards to claim 2, Isikoff teaches a hard drive that is coupled to the processor (column 4, lines 15-20).

16. With regards to claim 3, Isikoff teaches the beacon/modem processor (Fig. 3, element 30) that operates independently of the main processor (column 9, lines 15-27).

17. With regards to claim 4, Isikoff teaches that the beacon communication handling section logs unimportant requests, when the main processor is inactive, to be handled at another time to save power (column 9, lines 15-32).

18. With regards to claims 5 and 6, Isikoff teaches the beacon transmitting messages from memory when the main computer is powered down (column 6, lines 2-16, and column 9, lines 33-52).

19. With regards to claim 7, the memory stores user profile information regarding what types of files are to be transferred and stored in the memory (column 6, lines 2-16).

20. With regards to claim 10, While Isikoff does not explicitly teach non-volatile memory; the beacon is battery backed and retains power even when power is removed from the main computer and processor (Figs. 3 and 4). It would have been obvious to one of ordinary skill in the art at the time of invention that the beacon memory of Isikoff is at least battery backed and is therefore nonvolatile.

21. With regards to claim 11, Isikoff teaches that the beacon processor stores data into the memory (column 9, lines 15-32). Flash memory is well known in the art and it would have been

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obvious to one of ordinary skill in the art at the time of invention that the beacon memory could be a flash memory array.

22. With regards to column 12, Isikoff teaches the host computer being passed data to be processed (column 5, lines 47-51). It would have been obvious to one of ordinary skill in the art at the time of invention that the host processor would be involved in this access.

23. With regards to claims 15 and 16, Isikoff teaches the beacon processor stores user profile information in the memory regarding what types of files are to be transferred and stored in the memory (column 6, lines 2-16). It would have been obvious to one of ordinary skill in the art at the time of invention that either processor could have been used to store user profile identifying information into the memory.

24. With regards to claim 20, Isikoff teaches wireless communication with a modem (Figs. 1 and 3).

### ***Conclusion***

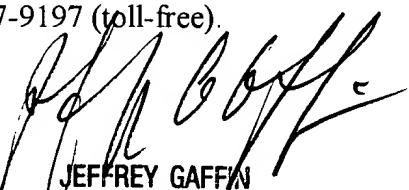
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Schneider whose telephone number is (703) 305-7991. The examiner can normally be reached on M-F, 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (703) 308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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